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**Today's Date: December 14, 2006**

To: **Examiner T. Alunkal, Art Unit: 2627**

**FAX: (571) 273-8300**

From: **Frederick E. Cooperrider #36,769**  
**McGinn Intellectual Property Law Group, PLLC**  
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In re Application of Neems, et al.

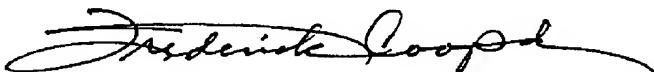
Serial No.: **10/697,271**

For: **METHOD AND STRUCTURE FOR ULTRA-HIGH DENSITY, HIGH DATA RATE FERROELECTRIC STORAGE DISK TECHNOLOGY USING STABILIZATION BY A SURFACE CONDUCTING LAYER**

Contents: 1. Response to Election/Restriction Requirement (3 pages)

**CERTIFICATION OF TRANSMISSION**

I certify that I transmitted via facsimile to (571) 273-8300 this Response to Election/Restriction Requirement to the USPTO to December 14, 2006.



Frederick E. Cooperrider  
Reg. No. 36,769

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YOR920030500US1 (YOR.495)

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

NEWNS et al

Serial No.: 10/697,271

Group Art Unit: 2627

Filed: October 31, 2003

Examiner: Alunkal, T.

For: METHOD AND STRUCTURE FOR ULTRA-HIGH DENSITY, HIGH DATA RATE FERROELECTRIC STORAGE DISK TECHNOLOGY USING STABILZTION BY A SURFACE CONDUCTING LAYER

Commissioner for Patents  
Alexandria, VA 22313-1450**RESPONSE TO ELECTION/RESTRICTION REQUIREMENT**

Sir:

In response to the Office Action dated November 14, 2006, in the above-referenced Application, wherein the Examiner required an election of one of the two identified inventions, Applicants hereby elect Invention I (e.g., claims 1-9 and 16-20) under traverse that the evaluation currently of record meets the analysis required for a combination/subcombination restriction requirement.

In the Office Action, the Examiner considers that claims 1-9 and 16-20 define Invention I, directed to a "storage medium and a method of manufacturing the medium, respectively, classified in class 428, subclass 834." The Examiner also considers that claims 10-15 define Invention II, directed to "a memory apparatus", and that the memory apparatus of Invention II is a combination that includes the subcombination defined in Invention I.

The Examiner also alleges: "... *the combination as claimed does not require the particulars of the subcombination as claimed because the memory apparatus does not require a ferroelectric layer as required by the storage medium. The subcombination has separate utility such as a memory apparatus for recording/reproducing a different type of optical disc.*"

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In response to the analysis of record, Applicants first point out that the Examiner's statement that the "... *memory apparatus does not require a ferroelectric data layer as required by the storage medium*" does not seem to be supported by the language of independent claim 10. That is, claim 10 reads: "*A memory apparatus, comprising: a support mechanism to support and move a ferroelectric storage medium, said ferroelectric storage medium comprising a metallic underlayer, a ferroelectric data layer over said metallic underlayer, and a conducting layer over said ferroelectric layer.*" This claim language would appear to be identical to the language of claim 1: "... *a ferroelectric data layer over said metallic underlayer ....*", so that Applicants do not understand the Examiner's point in this restriction requirement.

Thus, Applicants submit that it would appear that the claim language itself would not support the Examiner's evaluation that this layer is not required in the combination.

Second, Applicants also point out, assuming that the Examiner's classification, as based upon only a few selected words from the claim preambles, is correct, then a complete search would inherently require that both subclasses be searched in a search strategy that is based upon searching the designated subclasses. This fact, again, is based upon the similarity of the claim language, as pointed out above, so that a complete search would require that both subclasses be searched. Therefore, because of the necessity to search both subclasses, there is no undue burden on the Examiner.

Relative to the Examiner's allegation that "[t]he subcombination has separate utility such as a memory apparatus for recording/reproducing a different type of optical disc", Applicants again fail to understand the Examiner's point in this allegation, since both the apparatus and the medium claims are quite similar in wording. If the Examiner wants to maintain this restriction, Applicants respectfully request that the Examiner place on record a reasonably proper evaluation that is consistent with the claim language.

Finally, regardless of whether the Examiner agrees with the rationale of the above traversal, Applicants respectfully request that the Examiner begin the prior art evaluation on the elected invention, in order to get prosecution moving on at least the elected invention. Applicants specifically request that prosecution not be delayed and/or prolonged by the standard technique of a number of examiners who keep making repeated attempts at restriction until an applicant finally surrenders to a restriction simply

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to get prosecution moving on something, regardless of the correctness of the restriction requirement.

Therefore, in summary, Applicants submit that the Restriction/Election Requirement is improper in the instant case by failure of providing a reasonable analysis for a combination/subcombination restriction requirement. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this Requirement but that, even if the Examiner maintains the restriction of record, prosecution not be delayed by additional attempts of the Examiner to find another basis for restriction.

Early, favorable prosecution on the merits is respectfully requested.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A conditional petition is made for any extension of time which may become necessary. The Commissioner is authorized to charge any fees for such extension and to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



Frederick E. Cooperrider

Reg. No. 36,769

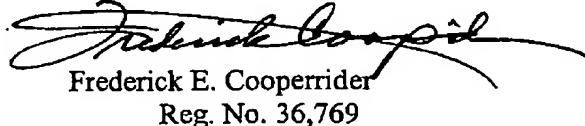
Date: 12/14/06

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